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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,785	10/27/2000	Alan William Atkinson	P-3530.001	8003

7590

04 22 2002

Robert L. Stearns
5291 Colony Drive North
Saginaw, MI 48603

EXAMINER

RAJGURU, UMAKANT K

ART UNIT	PAPER NUMBER
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1711

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DATE MAILED: 04/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____
This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-17 is/are pending in the application.
Of the above claim(s) 14 is/are withdrawn from consideration.
Claim(s) _____ is/are allowed.
☒ Claim(s) 1-13 is/are rejected.
Claim(s) _____ is/are objected to.
Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☒ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413
☒ Notice of References Cited, PTO-892 Notice of Informal Patent Application, PTO-152
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

Office Action Summary

Election/Restrictions

1. Restriction is required under 35 USC 121 and 372.

This application contains the following inventions or groups, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-13, drawn to a product.

Group II, claim 14, drawn to a method of using a product.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 1, at least, is anticipated or is rendered obvious by the prior art, such as EP 75396. As the recited coating does not make a contribution over the prior art, unity of invention is lacking and restriction is appropriate.

3. During a telephone conversation with Robert Stearns on January 17, 2002, a provisional election was made by without traverse to prosecute the invention of Group I, claims 1-13. Applicant in replying to this Office action must make affirmation of this election. Claim 14 is withdrawn from further consideration by the examiner, 37 CFR 1.1142(b), as being drawn to a non-elected invention.

4. Claims 1-13 are under examination.

5. Claims 7-9, 12 and 13 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple

dependent claims. See MPEP § 608.01(n). Accordingly, the claims 7-9, 12 and 13 have not been further treated on the merits.

Additionally claim 10 has also not been further treated on merit because it depends from claim 9.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 5, 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padget et al (EP 75396).

(Padget is of record on International Search Report).

Padget discloses aqueous coating compositions comprising a dispersion of chemically delaminated vermiculite lamellae in an aqueous solution or dispersion of a film-forming polymeric binder. Vermiculite lamellae are of size below 50 microns

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(abstract). Their aspect ratio is at least 10 and can be as high as 10,000 (page 3, lines 25-30). Amount of lamellae is 20-80% (page 5, lines 21-23). Suitable polymeric binders are shown on page 7 line 1 to page 8, line 15. Mixtures of polymers may be used if desired (page 7, lines 28 and 29). Composition may contain few other additives (page 9, lines 8-26).

Padget does not mention if the polymeric binders are resistant to heat to at least 300 °C (as claimed in instant claim 1). Since the composition of Padget was used for a flame test over a Bunsen burner it is reasonable to assume that polymers of patentee satisfy the limitation of thermal resistance. Therefore it would have been obvious to follow teaching of Padget and arrive at instant invention. Even though Padget does not specifically use the composition as a coating for gasket, it is within the expertise of one of ordinary skill in the art to use the disclosed composition for similar and suitable applications.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 5, 6, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Padget (EP 75396).

Disclosure of Padget, which is presented in concise form earlier, shows that above claims lack novelty.

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12. 11. 6

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10. Claim 1, 5, 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padgett et al (EP 75396) in view of Atkinson et al. (EB 2321470).

(Atkinson of record on International Search Report).

Disclosure of Padgett is summarized earlier.

76. K Padgett does not mention ~~phenolics~~^{phenolics} as a binder (of instant claim 5).

Atkins discloses seal material comprising exfoliated graphite, thermosetting resin and fibrous filler (abstract). Phenolic resin is a useful resin (page 2, paragraph 6).

Hence it would have been obvious to use phenolic resin as a binder in the composition of Padgett with the expectation of enhancing resistance of seal material towards heat as well as pressure.

11. Claims 2, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padgett et al (EP 75396) as applied to claim 1 above, and further in view of Grimwood, D. (USP 4962989)

Padgett, whose disclosure is presented earlier, fails to mention the silicon-containing polymer (of claims 2-4).

Grimwood discloses fire-resistant material useful for making gaskets (col. 1, lines 33-38) comprising ceramic fibers and fire resistant silicone-rubber compound which is methyl, phenyl silicone rubber (col. 5, lines 10-17, col. 6, lines 1-3).

Therefore it would have been obvious to use the silicone rubber of Grimwood as a binder in the composition of Padgett in order to enhance fire resistance of that composition and also that of gasket made therefrom.

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12. Claims 1-6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkinson et al (GB 2326201) in view of Atkinson et al (GB 2321470).

(Both references of record on International search report.)

Atkinson '201 discloses a gasket comprising a sealing layer formed from a resilient material comprising chemically exfoliated vermiculite, a hydrolysis-resistant polymer, coupling agent, talc, mica etc. (abstract). A silicone elastomer is a suitable polymer (page 3, paragraph 3).

Patentee fails to teach phenolic polymer of instant claim 5.

Atkinson '470 discloses sealing material using phenolic resin as binder.


Therefore, it would have been obvious to use phenolic resin as a binder in the gasket material of Atkinson '201 to improve resistance of gasket toward heat and pressure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U. K. Rajguru whose telephone number is (703) 308-3224. The examiner can normally be reached on Monday-Friday from 9:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 305-7115 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



U. K. Rajguru/dh
April 18, 2002



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700

Application/Control Number: 09/623,785

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DETAILED ACTION

Election/Restriction

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-13, drawn to a product.

Group II, claim 14, drawn to a method of using a product.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons : Claim 1, at least, is anticipated or is rendered obvious by the prior art , such as US x,xxx,xxx. As the recited coating does not make a contribution over the prior art, unity of invention is lacking and restriction is appropriate.

3. During a telephone conversation with Robert Stearns on Jan. 17, 2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-13. Affirmation of this election must be made by applicant in replying to this Office action. Claim 14 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.